

### **REMARKS/ARGUMENTS**

This amendment is submitted in response to the Office Action dated November 2, 2005. After entry of this amendment, claims 22-49 will be pending in the application, with claims 22, 28, 36 and 37 being independent. Reconsideration and allowance is respectfully requested in view of the remarks made below.

#### ***1. The Prior Art Rejections***

Claims 1-3, 8-10, 16-18 and 21-34 were rejected in the Office Action based on a proposed combination of U.S. Patent 5,253,780 to Adado ("Adado") and U.S. Patent 4,289,817 to Valyi ("Valyi"). Claims 35 and 36 were rejected based on a combination of Adado, Valyi and U.S. Patent 4,946,062 to Coy ("Coy"). Applicant respectfully but strenuously traverses all of these rejections and respectfully submits that such rejection should not be applied to new independent claim 37 and the claims depending therefrom, for the reasons set forth below.

The Office Action stated:

Adado discloses a drinking cup (12, Figures 6-7 and column 4, lines 3-6) with an elastomeric outer sleeve (14, Figures 6-7, abstract and column 4, lines 33-40). Adado does not teach that the outer sleeve is overmolded to the cup. Valyi discloses a drinking cup with an inner body (23, Figures 2A) and a single layer overmolding formed over the body (35, column 3, line 66 to column 4, line 15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of an inner body and a single layer overmolding formed over the body as disclosed by Valyi in the drinking cup disclosed by Adado to provide a method of producing the drinking cup that does not require the extra step of forming a sleeve from sheet material or the use of adhesive to secure the overmolding to the body.

Adado discloses a thermal drinking cup that has an insulating sheath 14 mounted on the sidewall 20 of the container. The insulating sheath 14 is clearly not an overmolding as is

specified in claim 1, and the Office Action recognizes this. It instead is preferably cut from an extruded sheet of closed cell polyolefin material that is laminated with an outer surface 38 of an extrusion coating.

Valyi discloses a method of making a decorated multi-layered hollow plastic container in which a decorated liner 23 is placed within a mold and a layer of hot, transparent hard plastic is injection molded around the decorated liner 23 to form a transparent or translucent outer layer 35. The composite article 34 that is so formed may then be used as a parison that can be heated and blow molded into a final desired configuration.

The first reason that the proposed combination of Adado and Valyi is legally inappropriate for a §103 rejection is that the Valyi reference constitutes nonanalogous prior art to Applicant's field of endeavor. MPEP 2141.01(a) describes the standard for evaluating whether or not prior art is analogous:

**2141.01(a) Analogous and Nonanalogous Art [R-3]**

**I. TO RELY ON A REFERENCE UNDER 35 U.S.C. 103, IT MUST BE ANALOGOUS PRIOR ART**

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved).

The Valyi reference relates primarily to the formation of a preform or parison for forming a decorative container. It does not relate to a drinking cup, the problems of grippability or condensation or breakability that occur on drinking cups, especially children's drinking cups, or

any other of the problems in the prior art that motivated Applicant's invention. It does not relate to insulation of drinking cups, which is the primary focus of Adado. Accordingly, it is not in the field of Applicant's endeavor. In addition, it would not have logically commended itself to an inventor in Applicant's position in considering the problems with which Applicant was faced while making the present invention. The hard, transparent coating that is provided by the process disclosed in Valyi would have no utility in providing a soft, elastomeric coating for a drinking cup is in the present invention.

In addition, the proposed combination of references that were used in the Office Action fails to provide a prima facie case of obviousness. MPEP 2143 sets forth the three basic requirements that are necessary to support a prima facie case of obviousness for a §103 rejection:

**2143 Basic Requirements of a Prima Facie Case of Obviousness**

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The proposed combination of Adado and Valyi that was applied in the Office Action fails all three of these basic requirements.

First of all, there is absolutely no suggestion or motivation either in the references themselves or in the knowledge generally available to one having ordinary skill in the art at the time Applicant's invention was made that reasonably would have led a hypothetical person of ordinary skill to modify the thermal drinking cup disclosed in Adado having an insulating sheath to include the structure that is allegedly disclosed in Valyi. This is true for a number of different reasons. The purpose of the insulating sheath 14 in Adado is to provide "an insulation means that greatly restricts the thermal conductivity of the heat transferred from the beverage held in the container 12 to the outer surface 38 of the sheath 14," as is stated in column 4, lines 61-65 of the reference. The transparent plastic that is used as an outer layer in the Valyi parison is not fabricated from a material that is known to have good insulating properties. Accordingly, to

substitute the transparent plastic of Valyi for the insulating sheath 14 in Adado would frustrate the basic purpose that accounts for the presence of the insulating sheath 14. Moreover, the purpose of providing the outer layer in Valyi is to create a hard transparent surface so that a decoration that is provided on the decorated liner 23 may be viewed. There is no corresponding decoration in Adado, so there would have been no motivation to apply such a transparent hard coating. Considering the completely different purposes of the outer layer in Valyi and the insulating sheath 14 in Adado, it is clear that the references considered in their totality actually teach away from the proposed combination rather than supporting it.

Second, there would have been no reasonable expectation of success if it were attempted to use the coating process taught in Valyi for the container that is disclosed in Adado. The Adado container is fabricated from a different material than the base Valyi container, and it is unclear whether there would be compatibility between the Adado container and the coating process and the coating material that is disclosed in the Valyi reference. There certainly would have been no expectation of success in creating a container having an elastomeric overmolding by using the hard plastic molding process taught in Valyi.

Third, even when hypothetically combined the resulting combination of these two references would not yield what Applicant is claiming. Newly submitted independent claim 37 specifies "an elastomeric overmolding at least partially covering said body," wherein the coating that is disclosed in Valyi is clearly not elastomeric. Claim 22 specifies that the first material must be harder than the second material, but the Valyi coating process that the Office Action relies upon to modify the Adado container does not disclose a hardness differential between the base material and the coating material.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Clearly, without the benefit of hindsight prompted by the availability of Applicants specification the idea of combining Adado and Valyi as proposed in the Office Action never would have occurred to a person having ordinary skill in this area of technology.

All of the outstanding rejections are premised on the combination of Adado and Valyi and are therefore legally inappropriate and should be withdrawn.

Applicant is also in the position of being able to show significant commercial success that is clearly linked to the claimed invention. If the Examiner is interested in reviewing evidence to this effect, Applicant would be happy to provide it.

## **2. Conclusion**

Applicant has made an earnest effort to place this application in condition for allowance. If the Examiner feels that a telephone interview would expedite prosecution of this patent application, he is respectfully invited to telephone the undersigned at 215-599-0602.

Respectfully submitted,

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